

## **REMARKS**

### **Substitute Specification**

It was felt that the most expeditious way of correcting the numerous grammatical and idiomatic inaccuracies present in the specification as filed was the preparation of a Substitute Specification. It is believed that the Substitute Specification overcomes the outstanding objections to the specification. The Substitute Specification is attached hereto and is accompanied by a marked-up copy of the original specification which indicates the changes made thereto by the Substitute Specification. No "new matter" has been added to the original disclosure by the Substitute Specification. Entry of the Substitute Specification is respectfully requested.

### **Abstract of the Disclosure**

Applicant is submitting a substitute Abstract of the Disclosure for that originally filed with this application to more clearly describe the claimed invention. Entry of the Substitute Abstract of the Disclosure is respectfully requested.

### **Drawings**

It is noted that the Examiner has accepted the drawings as originally filed with this application.

### **Claim Rejections**

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abileah (5,479,275) in view of Bernard (5,986,728).

New claim 13 is based on canceled claim 1, but is further directed to an optical waveguide device having, *inter alia*, multiple recesses which accommodate and ***partially surround*** each light source by ***substantially conforming to a curved surface*** of the light source. In addition, Claim 13 is also directed towards an optical wave-guide device having, *inter alia*, ***both an embossed lower surface and an embossed upper surface*** formed to refract and reflect light from each light source.

In comparison, Abileah teaches a backlit device having a reflective panel 74, overlying daytime lamps 70, a lens 65 located above the lamps 70, an optional diffuser 61, and matrix array of pixels 63 as the outermost layer. It is important to note that the lens 65 is only embossed on an upper surface and that, as admitted by the Examiner on p. 3 of the most recent Office Action, "Abileah does not explicitly disclose multiple recesses being provided to the optical wave-guide device to accommodate respective light sources.

Abileah does not teach multiple recesses which accommodate and partially surround each light source by substantially conforming to a curved surface of the light source. In addition, Abileah does not teach an optical wave-guide device having both an embossed lower surface and an embossed upper surface formed to refract and reflect light from each light source.

Bernard teaches a backlighting system including light reflectors 32 which are shaped to concentrate light from the fluorescent tubes 34 into a waveguide 18 including non-imaging optics lens 30 with an overlying diffuser plate 56. The non-imaging optics lens 30 includes a total internal reflection (TIR) lens 30, 30a and facets 36, all located on the lower surface of the waveguide 18. It is important to note that the upper surface of TIR lens 30, 30a lacks any facets and is shown as having a planar upper surface in Figures 3 and 4. In addition, the TIR lens 30, 30a are neither shaped to partially surround the fluorescent tubes 34, nor are the lens 30, 30a shaped to substantially conform to the curve of the fluorescent tubes 34. Instead, the lens 30, 30a are shown in Fig. 3 and 4 as forming a gradually arcing ceiling to form optical cells 26 which are much larger than the fluorescent tubes 34.

Bernard does not teach multiple recesses which accommodate and partially surround each light source by substantially conforming to a curved surface of the light source. In addition, Bernard does not teach an optical wave-guide device having both an embossed lower surface and an embossed upper surface formed to refract and reflect light from each light source.

Even if the teachings of Abileah and Bernard were combined, as suggested by the Examiner, the resultant combination does not suggest: multiple recesses which accommodate and partially surround each light source by substantially conforming to a curved surface of the light source; or an optical wave-guide device

having both an embossed lower surface and an embossed upper surface formed to refract and reflect light from each light source.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit.

Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Ablieah or Bernard that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Ablieah nor Bernard disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended and new claims.

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**Summary**

In view of the foregoing amendments and remarks, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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